

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID SUDA, TOM CUTHBERTSON,
MARK BUSCHER and LARRY CLEVENSTINE

Appeal 2006-3303
Application 09/675,180
Technology Center 1700

Decided: December 20, 2006

Before GARRIS, WARREN, and KRATZ, *Administrative Patent Judges*.
KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 19, 20, 32, and 33, the only claims that remain pending in this application.

Appellants' invention is directed to a backing sheet having stapling tabs that are disclosed as being useful as a component in manufactured insulation products. Sole independent claim 19 is illustrative of the claimed subject matter and is reproduced below:

19. A backing sheet for insulation, said backing sheet comprising:

a front side having an adherent material thereon;

a back side;

a stapling tab extending along an edge of said backing sheet, said stapling tab having a first portion of said back side positioned against a second portion of said back side; and

at least one hole extending through said backing sheet such that a portion of said adherent material extends through said at least one hole and contacts said back side.

The Examiner utilizes the following prior art reference as the sole evidence relied upon in asserting the obviousness of the claimed subject matter:

Arakawa US 5,591,521 Jan. 7, 1997

Claims 19, 20, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arakawa.

OPINION

Having considered the opposing arguments advanced by the Examiner in the Answer and Appellants in the Briefs and the evidence before us in support of their respective positions, we conclude that the Examiner has not established a *prima facie* case of obviousness for the claimed subject matter. Accordingly, we will not sustain the Examiner's § 103(a) rejection for the reasons set forth in Appellants' Briefs, and as highlighted in the discussion below.

Under 35 U.S.C. § 103(a), the Examiner carries the initial burden of establishing a prima facie case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). As part of meeting

this initial burden, the Examiner must determine whether the differences between the subject matter of the claims and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art” (emphasis added). 35 U.S.C. § 103(a)(1999); *Graham v. John Deere Co.*, 383 U.S. 1, 14, 148 USPQ 459, 465 (1966). The applied prior art references as a whole must be viewed from the perspective of one of ordinary skill in the art to determine whether “some suggestion” is present to arrive at the claimed subject matter. Cf. *In re Mills*, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972).

The Examiner correctly observes that Arakawa does not disclose a hole in their z-shaped pressure-sensitive adhesive tape (Answer 3 and 4). According to the Examiner, however, it would have been obvious to one of ordinary skill in the art to provide the z-shaped adhesive tape of Arakawa with a hole arranged to bond a first portion of a back side to a second portion of the back side of the z-shaped tape of Arakawa (Answer 4). As best understood from the Answer, an ordinarily skilled artisan would have found a suggestion/direction for this modification to the non-perforated z-shaped tape of Arakawa in the teachings in the background portion of the patent specification of Arakawa. According to the Examiner, this is because this background prior art disclosure, as discussed in Arakawa, would be taken as a broad disclosure of the tape of Arakawa as opposed to the preferred non-hole containing z-shape tape of Arakawa (Answer 6). We do not find the Examiner’s rationale for the proposed modification of Arakawa particularly persuasive in establishing a *prima facie* case of obvious for the here-claimed

subject matter for the reasons stated at pages 4-7 of Appellants' Brief and reiterated and expanded on in the Reply Brief.

In this regard, the Examiner incorrectly references column 1, lines 37-39 of Arakawa as a non-preferred and/or broader embodiment of Arakawa's z-shaped tape. In fact, that portion of the Background disclosure of Arakawa's patent discusses a prior art z-shaped tape that adheres a first leg to a third leg thereof via adhesive seeping through a hole in a second leg portion thereof and which prior art tape was deemed to render rewinding impossible according to Arakawa (col. 1, ll. 36-42). The Examiner has not fairly addressed how that prior art disclosure, as discussed in the Background of Arakawa, suggests a modification of the non-perforated z-shaped tape of Arakawa in the face of Arakawa's desire for a rewritable z-shaped tape as opposed to a non-rewritable tape. See Arakawa at col. 7, ll. 60-64. Nor has the Examiner otherwise explained how Arakawa would have reasonably suggested a product including a particular stapling tab along an edge thereof that corresponds to the here claimed backing sheet product.

On this record, we reverse the Examiner's obviousness rejection.

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CONCLUSION

The Examiner's decision to reject claims 19, 20, 32, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Arakawa is reversed.

REVERSED

clj

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